



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Davidson, Davidson, & Kappel, LLC
485 Seventh Avenue, 14th Floor
New York, NY 10018

COPY MAILED

JUN 27 2006

OFFICE OF PETITIONS

In re Application of
Obendiek et al
Application No. 10/663,333
Filed: September 16, 2003
Attorney Docket No. 487.1084

DECISION ON PETITION

This is a decision on the petition filed March 9, 2006, to withdraw the holding of abandonment. The petition was recently forwarded to the Office of Petitions for a decision on the merits. The Office sincerely apologizes for any inconvenience.

On June 15, 2005, the Office mailed a final Office action, which set a three-month shortened statutory period to reply. On February 13, 2006, the Office mailed a Notice of Abandonment. On March 9, 2006, petitioner filed the present petition to withdraw the holding of abandonment in the above-identified application.

In the petition, petitioner stated the Notice of Abandonment indicated that the Office did not receive a reply to the final Office action. Petitioner asserted that petitioner submitted a response on September 15, 2005 (certificate of mailing dated September 13, 2005) as evidenced by the returned, date-stamped postcard receipt. Petitioner submitted copies of the response and the returned, date-stamped postcard receipt with the present petition.

DISCUSSION

Initially, the Office must determine whether the application is, in fact, abandoned. Namely, the Office must review the present petition to evaluate if petitioner's assertions merely involve the cause of the abandonment. Therefore, where there is no dispute as to whether an application is abandoned because no disagreement exists regarding the sufficiency of the reply or controlling dates, the filing of a petition under 37 CFR 1.181(a) to withdraw the holding of abandonment would be inappropriate. See MPEP 711.03(c)(I). Instead, a petition under 37 CFR 1.137 (accompanied by the appropriate petition fee) is necessary to revive the abandoned application. See MPEP 711.03(c)(I).

Upon reviewing petitioner's response to the final Office action, the Examiner issued an Advisory Action Before the Filing of an Appeal Brief, which is enclosed. As stated in the Advisory Action,

petitioner's reply filed on September 13, 2005, failed to place this application in condition for allowance. A response to a final Office action may be entered if it places the application in condition for allowance. However, the admission or refusal to admit an amendment after a final rejection will not operate to relieve the application from its condition. Further, the entry of an amendment after a final rejection is not a matter of right.

In the present case, it is regrettable that the Office did not mail an Advisory Action until the date of this decision; however, it is clear from 37 CFR 1.116 that abandonment of an application is risked when an amendment is filed after a final Office action. Abandonment takes place by operation of law for failure to timely submit a proper reply to an Office action, not by the mailing of an Office communication, such an Advisory Action.¹ The mere filing of an amendment in response to a final Office action does not save the application from abandonment. Rather, the filing of a Notice of Appeal, a Request for Continued Examination accompanied by a proper submission, or a continuing application in response to a final rejection guarantees the pendency of the application.

CONCLUSION

The application is currently abandoned due to petitioner's failure to submit a proper response to the final Office action. Under the circumstances of this case, the application did not become abandoned due to a delay in reviewing the amendment or the mailing of the Advisory Action or any other error on the part of the U.S. Patent and Trademark Office. Accordingly, the petition to withdraw the holding of abandonment is dismissed. The application will remain in its abandoned state until petitioner files a petition to revive the application (accompanied by the appropriate petition fee).

The Office strongly encourages petitioner to file a petition under 37 CFR 1.137(b) on the basis of unintentional delay.

A grantable petition under 37 CFR 1.137(b) must be accompanied by:

- (1) The required reply to the outstanding Office action;
- (2) The petition fee as set forth in 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

¹ MPEP 711.03(c). See Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ 26, 299-30 (CCPA 1964); Krahn v. Comm'r, 15 USPQ2d 1823, 1824 (E.D. Va. 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1984).

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.



Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions